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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/718,155	11/21/2000	Koji Hayashi	10449-026001	8730
26161	7590	11/05/2004	EXAMINER	
FISH & RICHARDSON PC 225 FRANKLIN ST BOSTON, MA 02110			DINH, TAN X	
			ART UNIT	PAPER NUMBER
			2653	

DATE MAILED: 11/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/718,155

Applicant(s)

HAYASHI, KOJI

Examiner

TAN X. DINH

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1) The amendment filed 7/12/2004 is acknowledged.

2) The I.D.S filed 9/27/2004, 9/13/2004, 5/06/2004, 3/12/2004 and 12/17/2003 have been considered by the Examiner. However, the Japan and/or foreign document(s), if they have not been written in English, are considered to the extent that could be understood from the English Abstract and the drawings.

Form PTO-1449 or PTO/SB/08 is(are) attached herein.

3) The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970) and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed Terminal Disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of

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record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4) Claims 1-3 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of copending Application No. 09/717,772. Although the conflicting claims are not identical, they are not patentably distinct from each other because: the difference between claims 1-3 in this instant application and claims 1-3 of copending Application No. 09/717,772 is that the instant application recites (in preamble) a controller for controlling interruption and restarting data writing to a recording medium and the copending Application No. 09/717,772 recites (in preamble) a data recorder for writing data to a recording medium. However, this difference is not a patentable weight since the body of these claims recite the same structures and/or functions with each other and this would not make them a patentable distinction.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5) Claims 4-7 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4-7 of copending Application No. 09/717,772. Although the conflicting claims are not identical, they

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are not patentably distinct from each other because: the different between claims 4-7 in this instant application and claims 4-7 of copending Application No. 09/717,772 is that the instant application recites (in preamble) a controller for controlling interruption and restarting data writing to a recording medium and the copending Application No. 09/717,772 recites (in preamble) a data recorder for writing data to a recording medium. However, this different is not a patentable weight since the body of these claims recite the same structures and/or functions with each other and this would not make them a patentable distinction.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6) Claims 8-10 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 8-10 of copending Application No. 09/717,772. Although the conflicting claims are not identical, they are not patentably distinct from each other because: the different between claims 8-10 in this instant application and claims 8-10 of copending Application No. 09/717,772 is that the instant application recites (in preamble) a controller for controlling interruption and restarting data writing to a recording medium and the copending Application No. 09/717,772 recites (in preamble) a data recorder for writing data to a recording medium. However, this

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different is not a patentable weight since the body of these claims recite the same structures and/or functions with each other and this would not make them a patentable distinction.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7) Claim *II* is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim *II* of copending Application No. 09/717,772. Although the conflicting claims are not identical, they are not patentably distinct from each other because: the different between claim 11 in this instant application and claim 11 of copending Application No. 09/717,772 is that the instant application recites (in preamble) a method for controlling interruption and restarting data writing to a recording medium and the copending Application No. 09/717,772 recites (in preamble) a method for writing data to a recording medium. However, this different is not a patentable weight since the body of these claims recite the same structures and/or functions with each other and this would not make them a patentable distinction.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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8) Claim 12 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 12 of copending Application No. 09/717,772. Although the conflicting claims are not identical, they are not patentably distinct from each other because: the different between claim 12 in this instant application and claim 12 of copending Application No. 09/717,772 is that the instant application recites (in preamble) a method for controlling interruption and restarting data writing to a recording medium and the copending Application No. 09/717,772 recites (in preamble) a method for writing data to a recording medium. However, this different is not a patentable weight since the body of these claims recite the same structures and/or functions with each other and this would not make them a patentable distinction.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

9) Claim 13 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 13 of copending Application No. 09/717,772. Although the conflicting claims are not identical, they are not patentably distinct from each other because: the different between claim 13 in this instant application and claim 13 of copending Application No. 09/717,772 is that the instant application recites

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(in preamble) a method for controlling interruption and restarting data writing to a recording medium and the copending Application No. 09/717,772 recites (in preamble) a method for writing data to a recording medium. However, this different is not a patentable weight since the body of these claims recite the same structures and/or functions with each other and this would not make them a patentable distinction.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10) Applicant's arguments with respect to claims 1-13 have been considered but are moot in view of the new ground(s) of rejection.

11) Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAN X. DINH whose telephone number is (703) 308-4859. The examiner can normally be reached on Monday - Friday, 8:00AM - 5:30PM.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system.

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Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).



TAN DINH
PRIMARY EXAMINER

November 2, 2004